

### REMARKS

Claim 1 is amended, and no claims are canceled or added; as a result, claims 1-25 remain pending in this application.

Applicant amends claim 1 to clarify the language of the claim. This amendment is not made for purposes of patentability and should not affect the scope of the claim.

#### §103 Rejection of the Claims

In the Office Action, claims 1 – 3, 6 – 8, 10 – 14, 16, 17 and 19 were rejected under 35 USC § 103(a) as being unpatentable over Chekanov (U.S. Patent No. 6,201,991) in view of Dev et al. (U.S. Patent No. 6,347,247) and further in view of Eggers et al. (U.S. Patent No. 4,998,933). Applicant respectfully traverses.

The Office action fails to make out a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a) because the proposed combination of Chekanov, Dev, and Eggers fails to describe all of the features of claim 1. For example, Applicant is unable to find, in the three applied documents, generating the electrical field includes outputting a non-excitatory electrical field such that the electrical field does not interfere with the heart rhythm, as recited in amended claim 1. More specifically, applicant can not find where Chekanov teaches anything about heart rhythm and outputting a non-excitatory electrical field that does not interfere with the heart rhythm. Applicant can not find where Dev teaches anything about heart rhythm and outputting a non-excitatory electrical field that does not interfere with the heart rhythm. Applicant can not find where Eggers teaches this claim 1 feature.

Moreover, Chekanov teaches away from the present invention. For example, col. 2, lines 21-22 states that the electric pulse is effective to stimulate the muscle to contract . . . Claim 1 of the present application includes the feature of outputting a non-excitatory electrical field that does not interfere with the heart rhythm.

Applicant further requests clarification regarding the Office Action statement Dev et al. discloses a device to dilate vessels using electric fields to prevent plaque build-up (col. 2 @47-51; col. 6 @21-27). Applicant can not find where Dev teaches or suggests using electric fields to prevent plaque build-up. Dev merely teaches a device that dilates a vessel. Dev appears to be

silent with regard to preventing plaque build-up in an artery. Accordingly, there is no motivation to combine Dev with Chekanov.

The Office Action cites Eggers as teaching creating current flow along flux lines using stimulation that does not interfere with the natural pacing of the heart for the purpose of treating plaque safely. The Office Action does not indicate where Eggers teaches this feature. Applicant believes that his statement is too broad of a reading of Eggers. Eggers teaches a device that heats an occlusive mass in a vessel and presses against the mass to remove it. Applicant can not find where Eggers discusses preventing plaque build-up as recited in claim 1.

Applicant submits that claim 1 is allowable over Chekanov, Dev and Eggers, either alone or in combination. Applicant further submits that claims 2-3, 6-8, which depend at least in part on claim 1, are allowable with parent claim 1.

Claim 10 recites, in part, "an implantable electrical field generating device connected to the heart rhythm sensing unit, the electrical field generating device produces an electrical field that does not interfere with the heart rhythm". Applicant can not find this feature in Chekanov, Dev or Eggers. As the three applied documents do not teach all of the features of claim 10, applicant submits that claim 10 and claims 11-14, 16, 17 and 19 depending from claim 10 are allowable. Reconsideration is requested.

In the Office Action, claims 4, 5, 18 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Chekanov (U.S. Patent No. 6,201,991) in view of Dev et al. (U.S. Patent No. 6,347,247) and further in view of Eggers et al. (U.S. Patent No. 4,998,933) and further in view of KenKnight (U.S. Patent No. 6,317,615). Applicant respectfully traverses.

The present application and KenKnight (U.S. Patent No. 6,317,615) were, at the time the inventions in the present applicant, either owned by Cardiac Pacemaker Inc. or subject to assignment to Cardiac Pacemaker Inc. Thus, KenKnight is disqualified as prior art under 35 U.S.C. 103(c). The remaining references, Chekanov, Dev and Eggers, fail to teach or suggest each of the elements of claims 4, 5, 18 and 20. Thus, the office action fails to state a *prima facie* case of obviousness with respect to claims 4, 5, 18 and 20. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 4, 5, 18 and 20.

In the Office Action, claim 15 was rejected under 35 USC § 103(a) as being unpatentable over KenKnight (U.S. Patent No. 6,317,615) in view of Chekanov (U.S. Patent No. 6,201,991)

and further in view of Eggers et al. (U.S. Patent No. 4,998,933). Applicant respectfully traverses. KenKight is not available as prior art per 35 U.S.C. 103(c) as stated above. Applicant requests withdrawal of the rejections and reconsideration and allowance of claim 15.

Allowable Subject Matter

Applicant acknowledges the allowance of claim 9.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-349-9587) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

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Date 11 July '03

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11<sup>th</sup> day of July, 2003.



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